

### THE §103 REJECTION

Claims 1-6, 8, 10-16, and 18- 20 stand rejected under 35 USC §103 as being unpatentable over U.S. Patent No. 1,727,485 to Salley, and further in view of U.S. Patent No. 3,181,751 to Wilson. Claims 7 and 17, and 20 stand rejected under 35 USC §103 as being unpatentable over U.S. Patent No. 1,727,485 to Salley, and further in view of U.S. Patent No. 3,181,751 to Wilson, and further yet in view of U.S. Patent No. 5,345,633 to Harnish. Claim 9 stands rejected under 35 USC §103 as being unpatentable over U.S. Patent No. 1,727,485 to Salley, and further in view of U.S. Patent No. 3,181,751 to Wilson, and further yet in view of U.S. Patent No. 5,653,337 to Cirigliano. Insofar as they may be applied to the claims as amended, these rejections are respectfully traversed. Applicant respectfully submits that, for the reasons that follow, the Examiner has failed to establish a prima facie case for obviousness.

In Graham v. John Deere Co., 383 U.S. 1 (1966), the Supreme Court indicated that "under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level ordinary skill in the art resolved." 383 U.S. 1 at 17.

### SCOPE AND CONTENT OF THE PRIOR ART

**U.S. Patent No. 1,727,485 to Salley** is directed to an auto pocket article carrier adapted to be folded into compact form when detached or removed from the automobile (Salley page 1, lines 10-13). The auto pocket article carrier includes a plurality of flat pockets 3 (Salley page 1, lines 43-45), and requires an "anti-sagging means", in the form of a frame 9, for structural integrity (Salley page 1, lines 64-80).

**U.S. Patent No. 3,181,751 to Wilson** deals with a fishing tackle bag including a front wall member and a back wall member, to which a plurality of pockets 18 are attached. The pockets 18 are formed from a single sheet of material secured to the back member (Wilson Col. 1, Lines 39-46).

**U.S. Patent No. 5,653,337 to Cirigliano** is directed to a reversible tote bag adapted for the storage, display, accessing, and carrying of workman tools that is closable to form a tote bag (Cirigliano Col. 2, Lines 52-56).

**U.S. Patent No. 5,345,633 to Harnish** is directed to a cushion with an internal storage pouch. The Harnish device is in fact a head restraint provided with a rear panel having a zippered internal pouch (Harnish Col. 2, lines 37-46). "Thistle cloth" strips, e.g., Velcro strips, are provided to surround the seat back or to a user, thus securing the cushion (Harnish Col. 2, lines 51-68).

**DIFFERENCES BETWEEN THE PRIOR ART AND  
THE CLAIMS AT ISSUE**

Claims 1-20 recite structure and function that are not found in the references of record. Each of these claims requires "the compartments having an interior volume defined by a horizontal cross-section that increases in area with the height of the compartments, the compartments further being formed from a continuous front panel divided into compartments by spaced-apart, vertical separation seams" (Claim 1, lines 6-8; claims 11, and 19, lines 7-9).

The Salley and Cirigliano patents have flat pockets, and thus fail to teach the use of compartments having an interior volume defined by a horizontal cross-section that increases in area with the height of the compartments, the compartments further being formed from a continuous front panel divided into compartments by spaced-apart, vertical separation seams. The Wilson patent fails to teach such pockets, and is in no way adapted to be secured to a flat surface. The Harnish patent has no pockets whatsoever. No reference or permissible combination of references either teaches or suggests the compositions recited in applicant's claims.

**THE LEVEL OF ORDINARY SKILL IN THE ART**

A person of ordinary skill in the art would never be motivated to modify the framed carrier of Salley with the fishing tackle bag of Wilson, the carpenters tote of Cirigliano, and the headrest of Harnish in order to arrive at the storage device and method positively recited in Applicant's claims.

Each of Applicant's claims requires structure and function that is not present in any permissible combination of the cited references. In fact, the cited references, even if combined as set forth by the Examiner, expressly teach away from applicant's invention. The only possible source of motivation to combine the teachings of the cited patents as suggested by the Examiner is Applicant's disclosure. This is clearly impermissible.

Applicant submits that the question under §103 is whether the totality of the prior art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Merck & Co., Inc.*, 231 U.S.P.Q. 375 (Fed. Cir. 1986). The answer to this question with respect to Applicant's claimed invention is clearly "no".

It is insufficient that the prior art disclosed the components of the claimed device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor. *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1988). Individual references cannot be "employed as a mosaic to recreate a facsimile of the claimed invention."

Northern Telecom Inc. v. Datapoint Corp., 15 U.S.P.Q. 2d 1321, 1323 (Fed. Cir. 1990).

Even assuming that one of ordinary skill in the art would somehow have combined the references applied by the Examiner, the resultant combination would still lack critical features positively recited in the amended claims.

With the analysis of the deficiencies of the applied references in mind as enumerated above, there is no reason or suggestion in the evidence of record as to why one of ordinary skill in the art would have been led to produce the claimed invention. Therefore, *prima facie* obviousness has not been established.

The Examiner has failed to meet the test for obviousness as set forth in Graham v. John Deere Co. Withdrawal of the §103 rejection is in order, and therefore respectfully requested.

In view of the foregoing remarks and amendments, Applicant respectfully submits that claims 1 through 20 define allowable subject matter. The Examiner is requested to indicate the allowability of these claims, and to pass the application to issue.

Respectfully submitted,



Patrick N. Burkhart  
Reg. No. 33,352